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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/123,614 07/28/98 MIDDLEMAN L 12032

QM12/0204

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EXAMINER

RODRIGUEZ, C

ART UNIT

PAPER NUMBER

3763

DATE MAILED:

02/04/00

Please find below and/or attached an Office communication concerning this application or  
pr ceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/123,614

Applicant(s)

Middleman et al

Examiner

CJR

Group Art Unit

3763

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 11/1/99
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-23 is/are pending in the application.
- Of the above claim(s) 3-6, 12-21 & 23 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 2, 7-11 & 22 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election with traverse of species B)figure 5 claims 1, 2, 7-11 and 22 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that generic claim 1 includes sufficiently few species that a search and examination of the species A-F would have not impose a serious burden on the examiner. This is found in part persuasive because the Examiner agrees with Applicant that claim 1 is generic to claims 1-13 and 22 at this moment. However, the Examiner disagrees in that the search and examination of the species A-F would have not impose a serious burden on the examiner. According to the MPEP 806.04(e), claims may be restricted to a single disclosed embodiment (i.e. a single species, and thus be designated a specific species claim ), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a generic or genus claim). Species are always the specifically different embodiments. In section 806.04(f), set forth a test to check for mutually exclusive characteristics: "Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species, must recite the mutually exclusive characteristics of such species." This test has being applied to the claims

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and have been found that the claims are mutually exclusive. Therefore, as being drawn to independent species could have been a burden for the examiner for search and examination.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 3-6, 12-21 and 23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in Paper No. 5.

3. Please, note that claims 3-6, 12 and 13 have been withdrawn by the Examiner as being drawn to a non-elected species.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 10, 11, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayman et al(5,267,960).

Hayman et al disclose a device comprising a tubular element having a flexible, elongated hollow tubular lumen 15, a deployment means 13, and a plurality of resilient anchoring members 21,23 as claimed.

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*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayman et al in view of Cathcart et al(5,681,347).

Hayman et al disclose a back bone wire 25(guidewire) substantially as claimed. However, Hayman et al does not disclose a collar member coupled to the distal end of the guidewire.

8. Cathcart et al teaches a guidewire 17,31 having a collar 20 coupled to the distal end of the guidewire for support and displacement of the inner tubular member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hayman et al by providing the collar to the back bone wire 25(guidewire) as shown by Cathcart et al in order to provide support and displacement to the inner member.

9. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayman et al in view of Abrams(5,492,119).

Hayman et al disclose the invention substantially as claimed. However, Hayman et al does not disclose the anchoring members comprising a pseudo elastic material, and being nickel titanium alloy.

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Abrams teaches a catheter apparatus comprising control wires having curved feet made of nitinol for anchoring purposes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hayman et al by providing the pseudo elastic material nitinol as well known by Abrams for anchoring purposes.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Green et al., Lefebvre, Suma, Clark et al., Bar-Cohen et al, Sachdeva et al., Chin et al, Schreiner, Kirkman, Ortiz et al., Yoon et al., and Laptewicz et al all disclose devices analogous to that as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cris L. Rodriguez whose telephone number is (703) 308-2194. The examiner can normally be reached on Monday-Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, Corrine McDermott can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

*CR* 01/31/00  
Cris L. Rodriguez  
January 31, 2000

*CD*  
CORRINE McDERMOTT  
PRIMARY EXAMINER